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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,928	08/25/2000	Mark Benson	85ER-00155	4140

7590

03/24/2006

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EXAMINER
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MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



**Office Action Summary**

Application No.

09/645,928

Applicant(s)

BENSON ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



## DETAILED ACTION

### *Notice to Applicant*

1. In the amendment filed 12/28/05 the following has occurred: Claims 1, 3, 10, 15 and 23 have been amended. Claims 1-32 are presented for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 13-16 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,526,386 to Chapman et al. and “10-year term allows automatic renewal without underwriting” by National Underwriter: Life & Health/Financial Service (hereinafter “National Underwriter”) in view of “ClientSoft Introduces eXoro, A Complete e-Service Solution for the Insurance Industry” by Business Wire, for substantially the same reasons given in the previous Office Action (dated 8/1/05). Further reasons appear below.

(A) Claims 2, 4-9, 11, 13-14 and 16 have not been amended, and are rejected for the same reasons given in the previous Office Action (dated 8/1/05), and incorporated herein. Further reasons appear herein below.

(B) Claims 1, 3, 10, 15 and 23 have been amended to now recite the step of “providing pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment process, the no-underwriting eligibility criteria is pre-determined by the insurance carrier/policy issuer, the no-underwriting



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eligibility criteria including an insurance work classification assigned to a subscriber of the at least one identified renewal policy and a number of employees of the subscriber” and include “...the no-underwriting eligibility”.

As per this limitation, Chapman teaches that a list of expiring policies is generated automatically by the system on a periodic basis, preferably daily by comparing cancellation date of each policy of insurance with the current date (see: column 5, lines 49-53). Software interface (126, Fig. 5) running on central computer (124, Fig. 5) compares the cancellation data of each policy of insurance with the current date (see: column 5, lines 50-53). In addition, Chapman et al. teaches that the insurance carrier may optionally conduct verification either prior to the initial identification of each expiring policy (e.g. by classifying each expiring policy prior to expiration) or subsequent to ordering the renewal (see: column 6, lines 35-41). The Examiner considers the classification to be completed by the eligibility generator that determines which policies are eligible for renewal by the insurance carrier. Furthermore, comparing the “date” to generate a list of expiring policies is considered pre-determined criteria for determining each insurance policy eligible for a renewal.

Chapman fails to teach renewal evaluation without requiring external underwriting and risk assessment processes.

National Underwriter teaches a new policy that allows automatic renewal, without new underwriting at the end of the policy (see: abstract). The Examiner considers the newly implemented policy or procedure of automatically renewing policies without underwriting to meet the claimed limitation.



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One of ordinary skill in the art at the time the invention was made would have found it obvious to include renewal without underwriting and risk assessment as taught by National Underwriter within the system for generating automobile insurance certificates from a remote computer terminal as taught by Chapman with the motivation of enhancing the customer's overall experience regarding renewal policies thereby increasing the loyalty to the customer to the insurance agencies.

The other changes merely cancel words, but otherwise does not affect the scope and breath of the claim as originally presented and/or in the manner in which the Examiner when applying prior art with the previous Office Action interpreted the claims. As such, the recited claims features of claims 1, 3, 10, 15 and 23 are rejected for the same reasons given in the prior Office Action, and incorporated herein.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,526,386 to Chapman et al. and "10-year term allows automatic renewal without underwriting" by National Underwriter: Life & Health/Financial Service (hereinafter "National Underwriter") and "ClientSoft Introduces eXoro, A Complete e-Service Solution for the Insurance Industry" by Business Wire applied to claim 11 above, and further in view of Official Notice, for same reasons given in the previous Office Action (dated 8/1/06).

5. Claims 17-22 and 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,526,386 to Chapman et al. and "10-year term allows automatic renewal without underwriting" by National Underwriter: Life & Health/Financial Service (hereinafter "National Underwriter") and "ClientSoft Introduces eXoro, A Complete e-Service Solution for the Insurance Industry" by Business Wire as applied to claims 1, 3 and 23 above, and further in



view of U.S. Patent No. 6,604,080 to Kern, for same reasons given in the previous Office Action (dated 8/1/06).

***Response to Arguments***

13. Applicant's arguments filed 12/28/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response 12/28/05.

(A) In response to the Applicant's arguments, it is respectfully submitted that the Examiner has applied new citations and passages from the Chapman and Business Wire references to the amended features of amended claims 1, 3, 10, 15 and 23 at the present time. As such, Applicant's remarks with regard to the application of Chapman, National Underwriter, Business Wire, Official Notice and Kern to the amended claims are addressed in the above Office Action.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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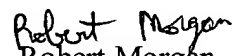
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Robert Morgan  
Patent Examiner  
Art Unit 3626

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER